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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,307

Applicant(s)

CHILDRESS ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-63, 65, 68-75, 79-82, 84, 87-97, 99 and 102-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-63, 65, 68-75, 79-82, 84, 87-97, 99 and 102-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>06/21/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed 05/20/04. Claims 60, 73-75, 79, 92-94, 107 and 108 have been amended. Claims 64, 66-67, 76-78, 83, 85-86, 98, 100, 101 and 109-115 have been canceled. Claims 60-63, 65, 68-75, 79-82, 84, 87-97, 99 and 102-108 are pending.

Claim Rejections - 35 USC § 112

2. Claims 60, 75, 79 and 94 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant incorporates language in the claims such as "from the first and/or second insurance claim", "and/or" "automatically modifying the sequence of processing steps". It is unclear what the phrase and/or means. Does it mean and or does it mean or? For purposes of examination, the Examiner will interpret the phrase and/or to be or. Appropriate correction is needed in the next correspondence.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 60, 73-75, 79, 92-94, 107 and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al (5,950,169) in view of Abbruzzese et al (5,557,515), for substantially the same reasons given in the previous Office Action. Further reasons appear hereinbelow.

(A) As per the added features to claim 60, Borghesi discloses the words "automatically", "automatically", "an ordered" "ordered", "automatically", "receiving input regarding the second insurance claim processing step (Col.15; lines 8-37). Borghesi does not explicitly disclose "automatically adding or deleting one or more steps from the table of contents in response to the received input from the first and /or second insurance claim processing step and/or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first and/or second insurance claim processing step".

However, these features are known in the art, as evidenced by Abbruzzese. In particular, Abbruzzese suggests "automatically adding or deleting one or more steps from the table of contents in response to the received input from the first and /or second insurance claim processing step and/or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first and/or second insurance claim processing step" (See Abbruzzese, Col.17, lines 22-67 to Col.18, line 30; Col.19, lines 1-35; Col.121, lines 27-36).

One of ordinary skill in the art at the time of the invention would have found it obvious to include the features of Abbruzzese within the system of Borghesi with the motivation of providing automatic classification and /or identification of the received

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information allowing it to be routed to a specific electronic address without going through a mail queue (See Abbruzzese, Col.10, lines 10-13).

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(B) Claims 73-74, 92-93 and 107-108 were apparently amended to include the words "that are" and "the". However, these changes do not affect the scope and the breadth as originally presented/or in the manner in which the claim were interpreted by the Examiner when applying prior art within the previous Office Action. As such, these claims are rejected under the same reason given in the prior Office Action, and incorporated herein.

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(C) As per the added feature to claim 75, Borghesi discloses "on a computer system", "displaying the table of contents on a display device coupled to the computer system, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim" (See Borghesi, Col.7, lines 1-67).

Borghesi does not explicitly disclose "automatically adding or deleting one or more steps from the table of contents in response to the received input from the selected insurance claim processing step and/or automatically modifying the sequence

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of processing steps listed in the table of contents in response to the received input from the selected insurance claim processing step”.

However, these features are known in the art, as evidenced by Abbruzzese. In particular, Abbruzzese suggests “automatically adding or deleting one or more steps from the table of contents in response to the received input from the selected insurance claim processing step and/or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the selected insurance claim processing step” (See Abbruzzese, Col.17, lines 22-67 to Col.18, line 30; Col.19, lines 1-35; Col.121, lines 27-36).

One of ordinary skill in the art at the time of the invention would have found it obvious to include the features of Abbruzzese within the system of Borghesi with the motivation of providing automatic classification and /or identification of the received information allowing it to be routed to a specific electronic address without going through a mail queue (See Abbruzzese, Col.10, lines 10-13).

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(D) As per the added features to claim 79, Borghesi discloses the words “automatically”, “in response to”, “automatically”, “an ordered”, “ordered”, “automatically”, “on the display device” (See Borghesi, Col.7, lines 1-67) “and”.

Borghesi does not explicitly disclose automatically add or delete one or more steps from the table of contents in response to the received input from the first and /or

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second insurance claim processing step and/or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first and/or second insurance claim processing step”.

However, these features are known in the art, as evidenced by Abbruzzese. In particular, Abbruzzese suggests automatically add or delete one or more steps from the table of contents in response to the received input from the first and /or second insurance claim processing step and/or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first and/or second insurance claim processing step” (See Abbruzzese, Col.17, lines 22-67 to Col.18, line 30; Col.19, lines 1-35; Col.121, lines 27-36).

One of ordinary skill in the art at the time of the invention would have found it obvious to include the features of Abbruzzese within the system of Borghesi with the motivation of providing automatic classification and /or identification of the received information allowing it to be routed to a specific electronic address without going through a mail queue (See Abbruzzese, Col.10, lines 10-13).

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(E) As the added features to claim 94, Borghesi discloses “on a computer system”, “automatically”, “automatically”, “an ordered”, “ordered”, “on the display device” (See Borghesi Col.7, lines 1-67; Col.10, lines 29-67) “and”.

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Borghesi does not explicitly disclose automatically adding or deleting one or more steps from the table of contents in response to the received input from the first and /or second insurance claim processing step and/or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first and/or second insurance claim processing step”.

However, these features are known in the art, as evidenced by Abbruzzese. In particular, Abbruzzese suggests automatically adding or deleting one or more steps from the table of contents in response to the received input from the first and /or second insurance claim processing step and/or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first and/or second insurance claim processing step” (See Abbruzzese, Col.17, lines 22-67 to Col.18, line 30; Col.19, lines 1-35; Col.121, lines 27-36).

One of ordinary skill in the art at the time of the invention would have found it obvious to include the features of Abbruzzese within the system of Borghesi with the motivation of providing automatic classification and /or identification of the received information allowing it to be routed to a specific electronic address without going through a mail queue (See Abbruzzese, Col.10, lines 10-13).

The remaining features are as addressed in the previous Office Action, and incorporated herein.

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(F) Claims 61-63, 65, 68-72, 80-82, 84, 87-91, 95-97, 99 and 102-106 have not been amended and are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

Response to Arguments

5. Applicant's arguments filed on 5/20/04 regarding claims 60, 73-75, 79, 92-94, 107 and 108 have been fully considered but they are not persuasive.

Applicant's arguments will be addressed hereinbelow in which they appear in the response filed 5/20/04.

(A) At pages 13-22 of the 5/20/04 response, Applicant argues the followings:

(1) The claims are not obvious over Borghesi in view of Abbruzzese Pursuant to 35 U.S.C. 103 (a).

(2) The feature of automatically displaying a table of contents on the display device, wherein the table of contents comprises an ordered list of steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps has not been taught or suggested by the cited prior art.

(3) Neither Abbruzzese or Borghesi, either alone or in combination, appear to teach automatically adding or deleting one or more steps from the table of contents in response to a user's input or automatically modifying the sequence of processing steps listed in the table of contents in response to received input.

(4) The prior art does not teach "Wherein insurance claim processing steps are associated with table of contents properties".

(5) Borghesi and Abbruzzese do not appear to teach or suggest a table of content associated with a claim identifier.

(B) With respect to Applicant's first argument, Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977F. 2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See the previous Office Action). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a

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holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300(Bd. Pat. App. & Inter., 4/22/93). Therefore, the combination of references is proper and the rejection is maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). Therefore, Applicant's argument is not persuasive.

Further, it is respectfully submitted that Applicant merely provides a piecemeal analysis of the teachings of the Borghesi and Abbruzzese references, separately, and in a vacuum. As such, it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, with specific reference to Applicant's remarks about the Goodman reference, the Examiner respectfully submits that it is sufficient to demonstrate that the prior art meets the limitations as claimed, whether by a single instance or scenario, or in

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every possible preferred embodiment, since it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

(C) With respect to Applicant's second argument, Examiner respectfully submits that Abbruzzese suggests "the selections from the menu screen (See Table LXXXII) are preferably as follows: insured business; insured home; claimant business; claimant home; attorney; witness; insured driver; service provider; investigative authority; agency; responsible party; contact business etc. which correspond to Applicant's claimed feature (See Abbruzzese, Col.107, lines 52-65 to Col.108, line 65).

Examiner relied upon Abbruzzese for the teaching of ordered list of steps associated with the processing of the insurance claim (See Table LXXXII of Abbruzzese).

In addition, for the teaching of the table contents, Examiner relied upon the reference of Borghesi. It is noted that Borghesi discloses "a generic claim processing workflow is illustrated. The claim workflow shown in Fig.1 is tailored specifically for automobile insurance claims. Other types of insurance such as property or health insurance may also be mapped into the claim workflow shown in Fig.1 which correspond to Applicant's claimed feature (See Borghesi, Col.4, lines 64-67 to Col.5, line 1). Furthermore, Borghesi states "The workfile preferably comprises a plurality of

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individual sections represented by tabs 102 that designate the contents of that section” (See Borghesi, Fig.6; Col.8, lines 65-67 to Col.9, line 2). Therefore, Borghesi and Abbruzzese disclose the claimed feature and Applicant’s argument is not persuasive.

(D) With respect to Applicant’s third argument, Examiner respectfully submits that Abbruzzese suggests “a list of screens specific to the automobile line of insurance business in their logical order of appearance (screens marked with asterisks will potentially become new claims): Policy information screen (required); Special procedures (optional unless extracted from Policy Index Table) etc. which also be interpreted as content of properties (See Abbruzzese, Col.19, lines 18-67). The list of screens correspond to an ordered set of processing steps that are displayed based on received input. Some of the screens are required and some are optional. The listing of displayed screens depend on the received input information. Therefore, Abbruzzese discloses deleting or adding one or more steps from the table of contents in response to the received input from an insurance claim processing step and Applicant’s arguments are nonpersuasive.

(E) With respect to Applicant’s fourth argument, the Examiner notes that Abbruzzese discloses (See Table XXVI) a directory table which contains a listing of codes which correspond to several names (See Abbruzzese, Col.39, line 47). The directory table represents a type of table of contents in that unique directory codes are listed along with their contents. The contents for each of the directory codes are processed by the claim

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processing steps. Therefore, the claim processing steps are associated with Table of Contents properties and Applicant's argument is not persuasive.

(F) With respect to Applicant's fifth argument, Examiner respectfully submits that Abbruzzese suggests "When the claim set-up screen is completed, pressing the appropriate function key activates an Automated Claim Numbering facility. This facility automatically assigns a number, from a pre-determined range, to each claim or record report of the LPTX (record reports are given numbers from a separate range apart from the range of claim numbers. These numbers are the primary method of accessing individual claims for processing and review" which correspond to Applicant's claimed feature (See Abbruzzese, Col.28, lines 51-58). Therefore, Applicant's argument is not persuasive.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on Monday-Thursday from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F
V.F

September 2, 2004


ALEXANDER KALINOWSKI
PRIMARY EXAMINER